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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,955	02/11/2004	Diane C. Breidenbach		4238

7590

12/15/2005

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EXAMINER
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DEVORE, PETER T

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/776,955

Applicant(s)

BREIDENBACH ET AL.

Examiner

Peter T. deVore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☒ Claim(s) 8, 15, 17 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4-24-05</u> | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Specification***

The abstract of the disclosure is objected to because the term “means” should not be used in the abstract. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because it does not mention the following Figures in the Detailed Description: 5, 6A, 6B, 6C, 7C, 8, 9, 10A, 10B, 11A, 11B, 11C, 12A, 12B, 12C. Appropriate correction is required.

### ***Claim Objections***

Claims 8, 15, 17, and 28 are objected to because of the following informalities. In claim 8, “polish, 7.” should be “polish.” In claim 15, “claim1” should be “claim 1”. In claim 17, “is a disk is” should be “is a disk located” or a similar phrase. In claim 28, “having and a base” should be “having a base”. Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,607,323.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are broader than the patent claims. Specifically, independent patent claims 1-3 are the same as independent application claims 1 and 30 except the patent claims include additional limitations, and dependent patent claims 4-31 are identical to dependent application claims 2-29.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 15-19, 21-26, and 30 rejected under 35 U.S.C. 102(b) as being anticipated by Gueret.

The Gueret reference discloses an applicator comprising a body 2b, a hollow reservoir with a round sidewall 2, a tapered tip 6, means for discharging 3, orifice 61,

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drive means/disk 41, screw means 43a, a driving member 43, a guide member 21, a recess 21b, a tear drop shaped surface 63, a perimeter canal 15, a vertical canal 16, a horizontal canal (on tip 6h, see Fig. 13), a cap 8, and a plug 82.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret in view of Lang.

Regarding claims 2-4 and 20, the Gueret reference discloses an applicator as discussed supra, but does not disclose a viewing window at the top and sides of the cap or at the hand-held reservoir exterior. However, the Lang reference discloses a similar applicator having a cap 34a with transparent top and sidewalls (see col. 4, lines 40-48) and transparent reservoir exterior (see col. 2, lines 24-29) thus forming viewing windows so that the user can see the contents of the applicator. It would have been obvious to employ a viewing window at the top and sides of the Gueret cap and at the hand-held reservoir exterior in view of Lang so that the user can see the contents of the applicator. Regarding claim 5, although Gueret remains silent as to the material of the cap, It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cap from PETG, since it has been held to be within the general skill of a

worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In *Re Leshin*, 125 USPQ 416.

Claims 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret in view of Trabattoni.

Regarding claims 6 and 8, the Gueret reference discloses an applicator as discussed supra, but does not disclose an opening in the body to receive a top portion of another container. However, the Trabattoni reference discloses a similar applicator whose body has an opening to receive a top portion of another container for convenient transport of nail polish. It would have been obvious to employ an opening in the body of the Gueret applicator to receive a top portion of another container in view of Trabattoni for convenient transport of nail polish. Regarding claims 7 and 9-14, although the Trabattoni reference does not disclose the other listed products, it would have been obvious to utilize the modified Gueret applicator to transport any of the other listed products as all such products are equally desirable to be transported for cosmetic purposes.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret in view of Yoshida.

The Gueret reference discloses an applicator as discussed supra, but does not disclose that the tip is made of a clear material. However, the Yoshida reference discloses a similar applicator having a tip of clear material (see col. 4, lines 24-26) so that the user can see the contents of the tip. It would have been obvious to employ a tip

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of clear material on the Gueret applicator so that the user can see the contents of the tip.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret in view of Lang as applied to claim 3 supra, and further in view of Green.

The Gueret reference discloses an applicator as discussed supra, but does not disclose that the plug is inserted into the orifice. However, the Green reference discloses a similar applicator wherein the plug is inserted into the orifice (see Fig. 4) for improved sealing of the orifice. It would have been obvious to modify the modified Gueret device so that the plug is inserted into the orifice in view of Green for improved sealing of the orifice.

### ***Allowable Subject Matter***

Claim 28 objected to as being dependent upon a rejected base claim, but would be allowable if the double patenting rejection and the claim objections are overcome and if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

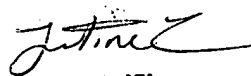
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter T. deVore whose telephone number is (571) 272-4884. The examiner can normally be reached on Monday to Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pd RJ

  
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SUPERVISORY PATENT EXAMINER  
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12/8/05